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10/730,586	12/08/2003	Thomas J. Mackey	DaGOOM-0303	4552

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,586

Applicant(s)

MACKEY, THOMAS J.

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,33,35,36,133-139,159,161 and 180-183 is/are pending in the application.
- 4a) Of the above claim(s) 181-183 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 133-136 is/are allowed.
- 6) ☒ Claim(s) 7,33,35,36,137-139,159 and 161 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 181-183 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: A method of playing a war game as disclosed in original claim 1 does not require a game piece having a movable indicator. As such prior art as Powell and Baca was able to be used for claim 1. This method can be used with a different game piece.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 181-183 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. The change to figure 1 is agreed with and the objection to the drawings is removed.
3. The specification is objected to under 37 CFR 1.71 for not being written in a clear and exact terms as to enable one skilled in the art to make and use the same. It is uncertain how to make a game piece having a rotating wheel integral with a game piece where the indicia on the wheel indicates character, attributes and values. The only movable wheel in the specification

and drawings is for movement counting and as such each time a game piece is moved the wheel turns. Each time the game piece is moved than the character indicia will always be changing.

Priority

4. This application does not meet the conditions of a Continuation of application 10/189,354 in that there is added mater in this application which was not present in application 10/189,354 (i.e. a wheel or sphere including indicia indicative of a character attributes (Claims 7, 33, 180)). As such either the added mater needs to be removed or this application must be changed to a Continuation-in-Part. The only rotating device in the parent cases have been for movement measuring only.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the wheel or sphere including indicia indicative of a character attributes as stated in claims 7, 33 and 180 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The added changes to the specification are agreed with and the rejections under 35 U.S.C. 112, first paragraph, are removed.

8. Claims 7-8, 33, 35-36, 138, 139, 159, and 161 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

Art Unit: 3711

invention. It is uncertain how to make a game piece having a rotating wheel integral with a game piece where the indicia on the wheel indicates character, attributes and values. The only movable wheel in the specification and drawings is for movement counting and as such each time a game piece is moved the wheel turns. Each time the game piece is moved than the character indicia will always be changing.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell, Matsumoto and Jorma.

Baca discloses a method of playing a miniature war game (Title) on a playing surface (Fig. 1) with a plurality of game pieces (Figs. 2-12), selected game pieces are representative of individual characters (Figs. 2-9), steps of simulating combat with a mathematical combat resolution in the form of determining the highest and lowest sum of rolled dice incorporating at least one randomizing element in the form of dice (Col. 8, Lns. 10-25), moving at least some of the game pieces representing the characters on the playing surface (Col. 7, Lns. 27-47), each game piece representing multiple distinct character attribute in the form of their purchasing cost,

combat value and type (i.e. ruler, king, soldier, etc...) (Col. 5, Lns. 60-67), a combat characteristic having an attack value in the form of power value utilized in the mathematical combat resolution (Col. 8, Lns. 10-25, Col. 8, Lns. 1-9), a physical characteristic in the form of value (purchasing value) (Col. 5, Lns. 60-67).

Baca lacks the multiple independent visible indicia indicative of distinct character attributes, indicia being numbers, indicia representing both value of the attribute and associated attribute, a step of measuring movement with a measurement mechanism distinct from the playing surface, and an indicia for physical characteristic of character type and a game piece having a rotating wheel integral where the wheel indicates indicia in the form of a number viewed through an aperture indicative of an(multiple) character attribute(s).

Powell discloses the multiple independent visible indicia in the form of numbers indicative of distinct character attributes and values of the attributes in the form of mobility and strength (Col. 4, Lns. 26-51, Figs. 8-14). In view of the patent of Powell it would have been obvious to modify the game of Baca to have multiple independent visible indicia in the form of numbers indicative of distinct character attributes and value of the attributes in order to make it easier for a player to remember the character attributes for each of the game pieces. In view of the patent of Powell it would have been obvious to modify the game of Baca to have additional attributes as a movement value with an independent visible indicia in the form of a number indicative of distinct character attributes or to have different values for cost and combat with different indicia associated with in order to make a game more complex.

Jorma discloses a war game with not squares but a step of measuring movement with a measurement mechanism distinct from the playing surface (Fig. 2) in order to have a boardless

game (Col. 1, Lns. 8-14). In view of the reference of Jorma it would have been obvious to modify the game of Baca to have with a step of measuring movement with a measurement mechanism distinct from the playing surface in order to have a boardless game.

Matsumoto discloses a miniature war game with indicia for physical characteristic of character type in the form of King and Pawns (Col. 3, Lns. 33-67, Fig. 1). For claims 7 and 137, in view of the patent of Matsumoto it would have been obvious to modify the game of Baca to have an indicia for physical characteristic of character type in order to reduce cost of manufacturing the game by not having to actually manufacture the form of a character type. Matsumoto discloses a game piece having a rotating wheel integral where the wheel indicates indicia indicative of a character attribute in the form of how many areas a piece may move (Col. 3, Lns. 33-50) and a separate indicia giving meaning to the value (Fig. 1). In view of the patent of Matsumoto it would have been obvious to modify the game of Baca to have a game piece having a rotating wheel integral where the wheel indicates indicia in the form of a number viewed through an aperture indicative of an(multiple) character attribute(s) (i.e cost, attack, movement) in order to be able to vary the characteristics for a game piece.

11. Claims 7-8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell, Weisman and Jorma.

Baca discloses a method of playing a miniature war game (Title) on a playing surface (Fig. 1) with a plurality of game pieces (Figs. 2-12), selected game pieces are representative of individual characters (Figs. 2-9), steps of simulating combat with a mathematical combat resolution in the form of determining the highest and lowest sum of rolled dice incorporating at

least one randomizing element in the form of dice (Col. 8, Lns. 10-25), moving at least some of the game pieces representing the characters on the playing surface (Col. 7, Lns. 27-47), each game piece representing multiple distinct character attribute in the form of their purchasing cost, combat value and type (i.e. ruler, king, soldier, etc...) (Col. 5, Lns. 60-67), a combat characteristic having an attack value in the form of power value utilized in the mathematical combat resolution (Col. 8, Lns. 10-25, Col. 8, Lns. 1-9), and a physical characteristic in the form of value (purchasing value) (Col. 5, Lns. 60-67).

Baca lacks the multiple independent visible indicia indicative of distinct character attributes, indicia being numbers, indicia representing both value of the attribute and associated attribute, a step of measuring movement with a measurement mechanism distinct from the playing surface, and an indicia for physical characteristic of character type and a game piece having a rotating wheel integral where the wheel indicates indicia in the form of a number viewed through an aperture indicative of an(multiple) character attribute(s).

Powell discloses the multiple independent visible indicia in the form of numbers indicative of distinct character attributes and values of the attributes in the form of mobility and strength (Col. 4, Lns. 26-51, Figs. 8-14). In view of the patent of Powell it would have been obvious to modify the game of Baca to have multiple independent visible indicia in the form of numbers indicative of distinct character attributes and value of the attributes in order to make it easier for a player to remember the character attributes for each of the game pieces. In view of the patent of Powell it would have been obvious to modify the game of Baca to have additional attributes as a movement value with an independent visible indicia in the form of a number

indicative of distinct character attributes or to have different values for cost and combat with different indicia associated with in order to make a game more complex.

Jorma discloses a war game with not squares but a step of measuring movement with a measurement mechanism distinct from the playing surface (Fig. 2) in order to have a boardless game (Col. 1, Lns. 8-14). In view of the reference of Jorma it would have been obvious to modify the game of Baca to have with a step of measuring movement with a measurement mechanism distinct from the playing surface in order to have a boardless game.

Weisman discloses a game piece having a rotating wheel integral where the wheel indicates indicia indicative of multiple character attributes [0037]. In view of the publication of Weisman it would have been obvious to modify the game of Baca to have a game piece having a rotating wheel integral where the wheel indicates indicia in the form of a number viewed through an aperture indicative of an(multiple) character attribute(s) in order to be able to vary the characteristics for a game piece.

12. Claims 33 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell, and Matsumoto.

Baca lacks at least one of the character indicia not being associated with a rotating element indicia.

Matsumoto discloses at least one of the character indicia not being associated with a rotating element indicia (Fig. 5, Ref. No. 36). In view of the patent of Matsumoto it would have been obvious to modify the game of Baca to have at least one of the character indicia not being

associated with a rotating element indicia in order to simplify the indicator by not having to change things that don't change.

See paragraphs above for elements of structure previously rejected by Baca in view of Powell and Matsumoto.

13. Claims 159 and 161 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell and Matsumoto as applied to claims 33, and 35-36 above, and further in view of Rhea.

Baca lacks providing a plurality of structural units for forming a variety of simulated structures including a castle positioned on the playing surface and building and placing selected simulated structures on a playing surface.

Rhea discloses a plurality of structural units for forming a variety of simulated structures including a castle positioned on the playing surface (Figs. 1-4) and building and placing selected simulated structures on a playing surface in the form of building a wall by placing structures on the playing surface (Fig. 1). In view of the patent of Rhea it would have been obvious to modify the game of Baca to provide a plurality of structural units for forming a variety of simulated structures including a castle positioned on the playing surface and building and placing selected simulated structures on a playing surface in order to add more atmosphere to the game.

14. Claims 137-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell, Jorma, Matsumoto and Rhea.

See paragraphs above for elements of structure previously rejected by Baca in view of Powell, Jorma, Matsumoto and Rhea.

15. Claims 137-138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell, Jorma, Weisman and Rhea.

See paragraphs above for elements of structure previously rejected by Baca in view of Powell, Jorma, Weisman and Rhea.

16. Claim 180 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell, and Matsumoto or Weisman.

See paragraphs above for elements of structure previously rejected by Baca in view of Powell, and Matsumoto or Weisman.

Response to Arguments

17. Due to the new ground of rejection under first paragraph of 35 U.S.C. 112, this action is not made final.

18. The argument that it is improper to combine the references of Powell with Baca since the cost of the character of Baca also determines the strength is disagreed with. The cost and power values are assigned (Col. 5, Lns. 61-67) though the amount may be doubled during the game (Col. 6, Lns. 43-60). The argument that it is improper to combine the references of Powell with

Art Unit: 3711

Baca since Baca uses a dice to determine movement and Powell doesn't is disagreed with. These are two of the most used ways in playing a game and it is obvious to substitute how movement is made. The dice requires more luck and movement without a dice requires more strategy. The argument that it is improper to combine the references of Baca and Matsumoto due to Matsumoto having a game piece movement determined by the specific position it is on the board is disagreed with. Matsumoto was used to show that it is known to use a rotating wheel to indicate attributes. Clearly it would be obvious to indicate the value attributes of Baca directly on a game piece as shown by Matsumoto. The values will be numbers. The argument that it is improper to combine the references of Baca and Jorma due to Baca including a game board is disagreed with. Jorma discloses a teaching of being able to due without a board. Clearly this teaching can be used for the game of Baca. The arguments that Jorma is improper due to Powell and Matsumoto also requiring a board are disagreed with. Powell was used to show the teaching of using multiple indicia for attributes on a game piece and Matsumoto was used to show that that indicia on a game piece can be a rotating wheel. The argument that it is not proper to combine the castle structures of Rhea with Powell is disagreed with. Baca moves game pieces as well as Rhea. Rhea shows how obstacles can be added to a game area adding additional concern for a player. Since claims 182-183 are directed an invention which was not the originally presented invention, these claims and any interference related to them will not be looked at.

Allowable Subject Matter

19. Claims 1-6 and 133-136 are allowed. With respect to claims 1-6, none of the prior art discloses or renders as obvious building a first simulated structure, at least disassembling a first structure, building a second structure, each game piece having multiple independent visible indicia indicative of distinct character attributes in addition to other elements of structure claimed. Whitman discloses a first simulated structure in the form of a fort wall, at least disassembling a first structure in the form of breaching the fort, building a second structure in the form of a second fort with a wall, each game piece having a single visible indicia indicative of a distinct character attribute in the form of type of soldier. Whitman lacks having multiple independent visible indicia indicative of distinct character attributes. With respect to claims 133-136, none of the prior art discloses or renders as obvious each game piece having multiple, independent visible indicia indicative of distinct character attributes, simulated building formed of a plurality of structural units, and simulating breaching of at least one simulated structure in at least one of the combat steps in addition to other elements of structure claimed.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone

Application/Control Number: 10/730,586

Page 14

Art Unit: 3711

number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 7 December 2004


STEPHEN BLAU
PRIMARY EXAMINER